REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 6, 11, 19, 20, 24, 25, 29 and 30 have been amended. Antecedent basis is located throughout Applicant's specification and the original claims. Claims 2, 7, 12, 16, 17, 21, 22, 26 and 27 have been cancelled. Claims 1, 4-6, 9-11, 14, 15, 18-20, 23-25 and 28-30 are pending.

Rejection of the claims

In the Office Action, independent claims 1, 6 and 11 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0162842 ("Ono"), and independent claims 19, 20, 24, 25, 29 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ono.

Claim 1 recites:

1.   A method performed by a computer system, comprising:
storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detecting a reference to a second location, wherein the second location is external to the paper, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the detected reference at the first location, wherein the hyperlink is selectable at the first location by a user to cause an operation associated with the second location; and
while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by the user to cause the operation associated with the second location.

Claim 6 recites:

6.   A system, comprising:
a computing device for:
      storing a version of a paper, the version being displayable on a display
          device as a likeness of the paper;
      at a first location within the version, detecting a reference to a second
          location, wherein the second location is external to the paper, and
          wherein the detected reference is at least one of the following, other
          than a computer network address: an alphanumeric character; a
          symbol; a term; and a phrase;
      in response to the detected reference, embedding a hyperlink within the
          detected reference at the first location, wherein the hyperlink is
          selectable at the first location by a user to cause an operation
          associated with the second location; and
      while the first location is displayed on the display device, highlighting the
          first location to indicate the hyperlink as being selectable at the first
          location by the user to cause the operation associated with the
          second location.

Claim 11 recites:

11.   A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:
    store a version of a paper, the version being displayable on a display device as a
        likeness of the paper;
    at a first location within the version, detect a reference to a second location,
        wherein the second location is external to the paper, and wherein the
        detected reference is at least one of the following, other than a computer
        network address: an alphanumeric character; a symbol; a term; and a
        phrase;
    in response to the detected reference, embed a hyperlink within the detected
        reference at the first location, wherein the hyperlink is selectable at the first
        location by a user to cause an operation associated with the second location;
        and
    while the first location is displayed on the display device, highlight the first
        location to indicate the hyperlink as being selectable at the first location by
        the user to cause the operation associated with the second location; and
apparatus from which the computer program is accessible by the computer system.

Claim 19 recites:

      19.   A method performed by a computer system, comprising:

storing a version of a paper, the version being displayable on a display device as a likeness of the paper;

      at a first location within the version, detecting a reference to a second location, wherein the second location is external to the paper, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;

      in response to the detected reference, embedding a hyperlink within the detected reference at the first location, wherein the second location is a file external to the paper, wherein the file includes audio signal information, and wherein the hyperlink is selectable at the first location by a user to cause an operation associated with the second location; and

      while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by the user to cause the operation associated with the second location, wherein the operation includes outputting audio signals in response to the audio signal information and a selection of the first location by the user.

Claim 20 recites:

      20.   A method performed by a computer system, comprising:

storing a version of a paper, the version being displayable on a display device as a likeness of the paper;

      at a first location within the version, detecting a reference to a second location, wherein the second location is external to the paper, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;

      in response to the detected reference, embedding a hyperlink within the detected reference at the first location, wherein the second location is a script, and wherein the hyperlink is selectable at the first location by a user to cause an operation associated with the second location; and

      while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by the user to cause the operation associated with the second location, wherein the operation includes executing the script in response to a selection of the first location by the user.

Claim 24 recites:

    24.   A system, comprising:

    a computing device for:

> storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
>
> at a first location within the version, detecting a reference to a second location, wherein the second location is external to the paper, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
>
> in response to the detected reference, embedding a hyperlink within the detected reference at the first location, wherein the second location is a file external to the paper, wherein the file includes audio signal information, and wherein the hyperlink is selectable at the first location by a user to cause an operation associated with the second location; and
>
> while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by the user to cause the operation associated with the second location, wherein the operation includes outputting audio signals in response to the audio signal information and a selection of the first location by the user.

Claim 25 recites:

    25.   A system, comprising:

    a computing device for:

> storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
>
> at a first location within the version, detecting a reference to a second location, wherein the second location is external to the paper, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
>
> in response to the detected reference, embedding a hyperlink within the detected reference at the first location, wherein the second location is a script, and wherein the hyperlink is selectable at the first location by a user to cause an operation associated with the second location; and
>
> while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by the user to cause the operation associated with the second location, wherein the operation includes executing the script in response to a selection of the first location by the user.

Claim 29 recites:

29.   A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:
  store a version of a paper, the version being displayable on a display device as a
    likeness of the paper;
  at a first location within the version, detect a reference to a second location,
    wherein the second location is external to the paper, and wherein the
    detected reference is at least one of the following, other than a computer
    network address: an alphanumeric character; a symbol; a term; and a
    phrase;
  in response to the detected reference, embed a hyperlink within the detected
    reference at the first location, wherein the second location is a file external
    to the paper, wherein the file includes audio signal information, and wherein
    the hyperlink is selectable at the first location by a user to cause an
    operation associated with the second location; and
  while the first location is displayed on the display device, highlight the first
    location to indicate the hyperlink as being selectable at the first location by
    the user to cause the operation associated with the second location, wherein
    the operation includes outputting audio signals in response to the audio
    signal information and a selection of the first location by the user; and
apparatus from which the computer program is accessible by the computer system.

Claim 30 recites:

30.   A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:
  store a version of a paper, the version being displayable on a display device as a
    likeness of the paper;
  at a first location within the version, detect a reference to a second location,
    wherein the second location is external to the paper, and wherein the
    detected reference is at least one of the following, other than a computer
    network address: an alphanumeric character; a symbol; a term; and a
    phrase;
  in response to the detected reference, embed a hyperlink within the detected
    reference at the first location, wherein the second location is a script, and
    wherein the hyperlink is selectable at the first location by a user to cause an
    operation associated with the second location; and
  while the first location is displayed on the display device, highlight the first
    location to indicate the hyperlink as being selectable at the first location by
    the user to cause the operation associated with the second location, wherein
    the operation includes executing the script in response to a selection of the
    first location by the user; and
apparatus from which the computer program is accessible by the computer system.

In MPEP § 2131, the PTO provides that:

> "[t]o anticipate a claim, the reference must teach every element of
> the claim...."

Therefore, to sustain a rejection of claim 1, Ono must contain all of the above-recited elements in claim 1. However, Ono fails to teach the combination of elements in claim 1. In fact, Ono teaches away from such a combination.

Regarding Ono, the Office Action states, "The KWIC and abstract documents are interpreted as locations within the version because both contain information extracted from the original version." Also, the Office Action states, "The examiner proposes that the computerized document, the KWIC document, and the abstract document, are all displayable on a display device as a likeness of the paper." If the Office Action is correct, then Ono clearly teaches away from claim 1, because claim 1 requires that the second location is *external* to the paper.

Moreover, Ono fails to embed its *clickable* link within the original document (nor within the KWIC document) at the location where Ono actually detected the keyword. Instead, Ono embeds its clickable link within the *abstract* document. In Ono, FIG. 12 shows an example of the abstract document. In paragraph [0156], Ono states, "'Internet' and 'Intranet' indicated by bold letters in the display in FIG. 12 are clickable and links *to* corresponding portion of the KWIC document are embedded therein" (emphasis added). Accordingly, in the last sentence of paragraph [0156], Ono states, "That is, the display is changed as shown in FIG. 14."

Thus, Ono clearly teaches away from claim 1, because claim 1 requires: *at a first location* within the version, detecting a reference to a second location; and, in response to the detected reference, *embedding a hyperlink within the detected reference at the first location,* wherein the hyperlink is *selectable at the first location* by a user to cause an operation associated with the second location.

Accordingly, Ono fails to support a rejection of claim 1 under 35 U.S.C. § 102(e). In relation to claims 6 and 11, Ono is likewise defective in supporting a rejection under 35 U.S.C. § 102(e).

Moreover, as stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Also,

MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In relation to claim 1, Ono is defective in establishing a prima facie case of obviousness. As between Ono and Applicant's specification, only Applicant's specification teaches the combination of elements in claim 1. In fact, Ono teaches away from such a combination. Accordingly, the PTO's burden of factually supporting a prima facie case of obviousness has not been met.

In relation to claims 6, 11, 19, 20, 24, 25, 29 and 30, Ono is likewise defective in establishing a prima facie case of obviousness.

Thus, a rejection of claims 1, 6, 11, 19, 20, 24, 25, 29 and 30 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 6, 11, 19, 20, 24, 25, 29 and 30.

Dependent claims 4, 5 and 18 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 9, 10 and 23 depend from and further limit claim 6 and therefore are allowable.

Dependent claims 14, 15 and 28 depend from and further limit claim 11 and therefore are allowable.

An early formal notice of allowance of claims 1, 2, 4-7, 9-12, and 14-30 is requested.

To the extent that this Accompanying Amendment results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

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Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

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